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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,626	05/18/2004	John Elasic	12051-00001-US	3625
23416	7590	06/12/2006	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			CLEMENT, MICHELLE RENEE	
			ART UNIT	PAPER NUMBER
			3641	

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/709,626	Applicant(s) ELASIC, JOHN	
	Examiner Michelle (Shelley) Clement	Art Unit 3641	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102 & § 103*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 5, 8, 10-12 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Davey (US Patent # 2,316,055). Davey discloses a ballistic shield comprising a shield having a front face and a reverse face and formed of a ballistic material, a viewing window through the shield, handles associated with the shield that can be used for carrying the shield or holding the shield in front of at least a portion of a user's body or used as a forearm cuff and multiple firearms (not shown see page 2, lines 40-55) mounted to the shield and dischargeably operable when so mounted, wherein the firearm is mounted for discharge in a direction at an angle outwardly from the front face of the shield. The firearm is a pistol. The firearms are mounted so that they discharge in a plurality of directions including a direction substantially perpendicular to the front face of the shield. The shield can be employed and the firearm can be discharged with a single arm (presumably depending on the strength and dexterity of the user). Multiple firearms are mounted when shields are combined, it is inherent that the firearms can be discharged in any direction outward from the face of the shield including substantially perpendicular and

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substantially parallel to the shield. It is noted that the [a) statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

4. As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davey as applied to claim 1 above. Davey discloses the claimed invention except for the specific ballistic

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material selected from the claimed group or the material of the viewing window specifically selected from the claimed group. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the specific materials in making the shield, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and Davey discloses that such known materials are used in the construction of the shield. *In re Leshin*, 125 USPQ 416.

7. Claims 6, 7, 13, 14, and 16 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey as applied to claim 1 above, and further in view of Resnick (US Patent # 6,272,781). Although Davey does not expressly disclose a taser gun and battery and various sensors and communications devices mounted to the shield, Resnick does. Resnick teaches a ballistic shield comprising a shield having a front face and a reverse face and formed of a ballistic material; a handle associated with the shield and a taser gun mounted to the shield and dischargeably operable when so mounted. Although Resnick does not expressly mention the battery it is inherent that a power source (i.e. battery) would be present, since the taser gun would not operate without such a source. The shield further comprising a disabling sensor the disable the firing devices in response to a predetermined signal or a predetermined absence of a signal. The shield comprising a plurality of communication accessories mounted to the shield selected from the claimed group, and further comprising a plurality of light sources. Davey and Resnick are analogous art because they are from the same field of endeavor: protective shields. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the taser gun as taught by Resnick with the shield taught by Davey. The

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suggestion/motivation for doing so would have been to obtain a shield that provided the additional protections and advantages as suggested by Resnick.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey as applied to claim 1 above, and further in view of Lobdell (US Patent # 1,227,544). Although Davey does not expressly disclose a mirror associated with the viewing window, Lobdell does. Lobdell teaches a mirror that can be mounted on a firearm to increase the field of vision. Lobdell and Davey are analogous art because they are from similar problem solving areas: protection while firing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the mirror as taught by Lobdell with the firearms and shield taught by Davey. The suggestion/motivation for doing so would have been to obtain a shield that had an extended field of view.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey and Resnick. See ¶ 6 above.


### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Moloney (US Patent # 1,279,571), Molving (US Patent # 1,301,293), Larnell (US Patent # 1,281,400), Chaires (US Patent # 4,245,546), Adams (US Patent # 377,732), Korn (US Patent # 1,308,286), Russell (US Patent # 2,020,702), Martinson (US Patent # 1,466,669), and Carrino (US Patent # 1,282,752).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
MICHELLE CLEMENT  
PRIMARY EXAMINER